

**REMARKS**

Claims 11 to 24 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph two (2) of the Final Office Action, claims 11 to 24 were rejected under the first paragraph of 35 U.S.C. § 112, as to enablement.

While the rejections may not be agreed with, to facilitate matters, claims 11 and 18 have been rewritten herein without prejudice to provide "a plurality of springs," and to provide that the Coriolis element is "connected to the drive element by the plurality of springs." Support for these features are disclosed in the Specification (e.g., at page 4, lines 25-26). It is therefore respectfully requested that the enablement rejections be withdrawn.

As to claim 19, while the rejection may not be agreed with, to facilitate matters, claim 19 has been rewritten without prejudice to delete the terms "electromechanical," "multiplicand," and "multiplier." Therefore, the enablement rejections are plainly obviated by the foregoing.

As regards the enablement rejections of the claims, it is respectfully submitted that the Office Action's assertions and arguments presented do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention -- which is defined by the claims. See M.P.E.P. § 2164. The Supreme Court established the appropriate standard as to whether any experimentation for practicing the invention was undue or unreasonable. See M.P.E.P. § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988)). Thus, it is axiomatic that the enablement test is "whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *Id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988)).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement,

and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. *See id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner's analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” *Id.*

Also, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” *Id.* (citing *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993)). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. *See id.*

In contrast to the above, however, it is respectfully submitted that the Office Action's unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as would be understood by a person having ordinary skill in the art in view of the disclosure of the present application, including the specification. In short, the Office Action's assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — *a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.*

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the

specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any "evidence or sound scientific reasoning" and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in *Ex parte Reese* was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. *See id.* Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." *See id.* at 1222-23 (*italics in original*).

In the present case, the Final Office Action has not even properly asserted — let alone properly established -- that undue experimentation would be required.

Accordingly, claims 11, 18, and 19 are allowable, as are claims 12 to 17 and 20 to 24, which depend from claim 11.

Approval and entry are respectfully requested, as is withdrawal of the enablement rejections.

As to paragraph four (4) of the Final Office Action, claims 19, and 21 to 24 were rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

While it is believed that claims 19 and 21 to 24 are definite as presented, to facilitate matters, claims 19, 21, and 22 have been rewritten to better clarify the claimed subject matter.

As to claims 19 and 22, the terms "electromechanical," "multiplicand," and "multiplier" are deleted.

As to claim 21, while the rejection may not be agreed with, to facilitate matters, claim 21 has been rewritten herein without prejudice to delete the phrase

"wherein the force-conveying arrangement directly conveys the dynamic action between the substrate and the Coriolis element."

Accordingly, it is respectfully submitted that claims 19, 21, and 22, as presented, are definite, so that claims 19, 21, and 22 are allowable, as are their respective dependent claims.

Approval and entry are respectfully requested, as is withdrawal of the indefiniteness rejection.

Accordingly, claims 11 to 24 are allowable.

### CONCLUSION

In view of the above, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since they have been obviated. Since all issues raised have been addressed, an early and favorable action on the merits is respectfully requested.

Dated: \_\_\_\_\_

*12/16/2009*

Respectfully Submitted,

By: \_\_\_\_\_

*[Signature]*  
Gerard A. Messina  
(Reg. No. 35,952)

KENYON & KENYON LLP  
One Broadway  
New York, NY 10004  
(212) 425-7200

CUSTOMER NO. 26646

*33,865*

*Are C  
DEDUCT*